

REMARKS

The Examiner is thanked for the very thorough and professional Office Action. Pursuant to that Office Action, Claims 1-4 have been amended to more definitely set forth the invention and obviate the rejection. Support for these amendments can be found in the original Claims 1-4. In new Claim 1, a first layer foundation composition is restricted only to Composition No. 3. In addition, new Claims 5 and 6 have been presented herein. New Claim 5 is directed to a kit containing a first layer foundation composition which is Composition No. (1) and a second layer finishing composition. New Claim 6 is directed to a kit containing a first layer foundation composition which is Composition No. (2) and a second layer finishing composition. In new Claim 6 the silicone oil has been restricted to a silicone oil having a viscosity of 1 – 1,000 mPa's at 25°C. Support for this limitation can be found in original Claim 1. The present amendment is deemed not to introduce new matter. Claims 1-6 are in the application.

Reconsideration is respectfully requested of the rejection of Claims 1-4 under 35 U.S.C. § 112, first paragraph, as containing subject matter not described in the Specification as originally filed. With respect to the Examiner's indication that there was no recitation of a "kit" in the original disclosure, the Examiner's attention is directed to page 55, lines 11-20, wherein it is indicated that the multilayer cosmetic composition may assume a "multi-layer makeup kit". It is therefore submitted that there is ample support in the original Specification as filed for the term "kit" as now used in the claims. ✓

With respect to the expression in Claims 1-4 of "a regular reflection percentage of 1% or less in an amount of 1 – 100 wt% and a second powder, at least one of a regular reflection percentage

and a diffuse reflection percentage of which is more than 5%, and an amount of less than 10 wt%”, it is respectfully submitted that there was ample disclosure in the original Specification for this expression in the claims.

The second layer finishing composition contains powder with minimized regular reflection and diffuse reflection (reflection-minimized powder, or a first powder) in an amount of 1-100 wt.% and may contain reflection powder (a second powder) in an amount of less than 10 wt.%. The reflection-minimized powder is described in detail in the Specification on page 44, lines 20-27, and on page 50, line 18, to page 51, line 6. In order to avoid using the term “minimized”, the reflection-minimized powder is defined as a first powder by using regular reflection percentage and diffuse reflection percentage in claim 1. The amount of the reflection-minimized powder in the second layer finishing composition is described in the Specification on page 52, lines 15-21. The examples of the reflection-minimized powder are mentioned in Table 1 (1).

The reflection powder is described in the Specification on page 52, lines 2-10. The reflection powder is also defined as a second powder by using regular reflection percentage and diffuse reflection percentage in claim 1. The amount of the reflection powder in the second layer finishing composition is described in the Specification on page 52, lines 15-24. The examples of the reflection powder are mentioned in Table 1 (3). In addition, please see on page 53, line 11, to page 54, line 10.

Therefore, it is respectfully submitted that all of the terms referred to by the Examiner in Claims 1-4 were described in the Specification as originally filed. It is also respectfully submitted that one of ordinary skill in the art would understand the Specification to disclose the subject matter in the terms used in the claims. Therefore, it is respectfully submitted that the Examiner would be

justified in no longer maintaining this rejection. Withdrawal of the rejection is accordingly respectfully requested.

Reconsideration is respectfully requested of the rejection of Claims 1-4 under 35 U.S.C. § 112, second paragraph, as being indefinite. First, the Examiner indicates that the term “low” in Claim 1 is a relative term and indefinite. Claim 1 has been amended so as to delete the term “low” in the claim.

Second, with respect to the Examiner’s objection to the term “first powder having a regular reflection percentage of 1% or less in an amount of 1 – 100 wt.%”, Claim 1 has been amended to indicate that the wt.% is on the basis of the entirety of the finishing composition. An explanation of regular reflection and reflection minimized powder as used in the claims herein can be found in the Specification on page 50 in the last paragraph bridging pages 50 and 51. It is respectfully submitted that these terms as used in the claims are clearly defined in the Specification so as to enable one of ordinary skill in the art to understand the meaning of these phrases.

Third, the Examiner’s objection to Claim 4 as vague is noted, Claims 1 and 4 having been amended to obviate the rejection. Fourth, the objection to Claim 1 as being vague is noted, and accordingly, Claim 1 has been amended to obviate this rejection. It is now believed with the amendment of the claims herein, that the claims now in the case are definite as required by the second paragraph of 35 U.S.C. § 112. Consequently, it is believed that the Examiner would be justified in no longer maintaining the rejection. Withdrawal of the rejection is accordingly respectfully requested.

Reconsideration is respectfully requested of the rejection of Claims 1-4 under 35 U.S.C. §

103(a) as being unpatentable over JP 6-128122 ('122) in view of JP 9-194323 ('323).

The cited JP '122 reference is directed to makeup compositions comprising a first layer foundation composition and second layer foundation finishing composition. However, as the Examiner has correctly recognized on page 4 of the instant Office Action, the cited JP '122 reference fails to teach a first layer foundation composition containing a polyether modified as silicone, water and a hydrophobic powder in addition to the silicone oil. Furthermore, the cited '122 reference fails to disclose or suggest that limiting a finishing layer containing a reduced amount of reflection powder, such a titanium oxide and mica, to no more than 10 wt% of the finishing layer, provides a natural appearance to the skin while simultaneously allowing the first layer of the multilayer composition to conceal irregularities in the skin. Rather, this teaching comes only from the present invention, and constitutes an important element or aspect thereof.

The cited JP '323 reference teaches a cosmetic composition containing a silicone oil, a polyether-modified silicone of the formula instantly claimed, water and hydrophobic powder, but fails to teach a second layer finishing composition containing 1-100 wt.% of the reflection minimized powder and less than 10 wt.% of the reflection powder, as claimed herein, the combination of which allows a user to achieve the object of the present invention.

Importantly, as mentioned above, the reflection powder incorporated into the second layer of finishing composition is in an amount of 10.0 wt.% or less, as now claimed herein in amended Claim  
 1. If the reflection powder is contained in an amount of 10.0 wt.% or more on the basis of the entirety of the finishing composition, a powdery or white appearance attributable to the reflection powder occurs, thus defeating one of the objectives of the present invention, i.e., to impart a natural

appearance to human skin while simultaneously concealing blemishes thereon (see Specification, page 53).

In conventional multilayer cosmetic compositions, a first layer and a second layer composition are present wherein the first layer composition generally acts merely to adhere the second layer of the composition onto the skin, but does not conceal skin pores. In contrast, in the present invention, it was unexpectedly discovered that while the first layer foundation composition of the multilayer cosmetic composition is able to provide a smooth appearance and correct/conceal blemishes and skin pores, the second layer finishing composition allows application of a thin coating of the first layer foundation composition to the skin to be sufficient for concealment of blemishes and skin pores while, in addition, simultaneously imparting a natural appearance.

Proof of an unexpected improvement can rebut a prima facie case of obviousness. In re Murch, 464 F2d 1051, 175 USPQ 89 (CCPA, 1972). In re Costello, 480 F2d 894, 178 USPQ 290 (CCPA, 1973). The chemical compound and its properties are inseparable. A formula is not the compound nor what is patented. Patentability does not, therefore, depend solely on the similarity of the formula of the claimed compound or that of a prior art compound. The unobviousness of its properties must also be considered. In re Papesch, 315 F2d 381, 137 USPQ 43 (CCPA, 1963); In re Ward, 329 F2d 1021, 141 USPQ 227 (CCPA, 1964); In re Stemniski, 444 F2d 581, 170 USPQ 343 (CCPA, 1971)

"Synergism" is a very broad term and means "combined action of two or more agents... that is greater than some of the action of one of the agents used alone...". In re Luvisi, et al., 342 F2d 102, 144 USPQ 646 (CCPA, 1965). The evidence should at least demonstrate an effect greater than the

sum of the several effects taken separately. Merck & Co., Inc. v. Biocraft Laboratories, Inc., 874 F2d 804, 10 PQ 2d 1843 (CAFC, 1989). There are undoubtedly many appropriate tests for determining synergism. In each case the facts must be analyzed to determine whether the chosen method as in fact clearly and convincingly demonstrated an unobvious result. Ex parte Quandranti, 26 PQ 2d 1071 (BPAI, 1992).

The present invention provides a cosmetic kit that enables application of a multilayer cosmetic composition onto the skin of a user, wherein the first layer foundation conceals skin blemishes and hides skin pores, while the second finishing layer foundation allows a natural appearance to be realized while still covering said blemishes. It was unexpectedly discovered that a synergistic effect is obtained by the combination of the first layer foundation and the second layer finishing composition, an effect magnified greatly over the effect achieved when using the components alone/separately. To demonstrate these unexpectedly improved and synergistic results using the multilayer cosmetic composition of the present invention, the present inventors conducted a series of comparative tests using twenty panelists, as outlined on page 61 of the Specification. The results of these tests may be found in Tables 2, 4 and 5 on pages 64, 66 and 69 of the Specification. In particular, the comparative tests shown in Table 2 demonstrate the synergistic effectiveness of the compositions of the present invention as now claimed in concealing irregularities of the skin while imparting a natural appearance to the skin. The test results shown in Table 4 of the tests comparing the comparative examples 1-3 to the compositions of the present invention (identified as P EX.1-6) clearly demonstrate that the compositions of the present invention provide much improved natural appearance over the compositions of the prior art. However, as shown in

Table 4, when using a conventional cosmetic foundation composition with the second layer finishing composition of the present invention applied thereon, concealment of irregularities in the skin is not achievable.

If the foundation composition of JP '323 is substituted for the first layer foundation composition of JP '122, a powdery appearance is imparted. Please see, in particular, combination 6 in table 5. Combination 6 corresponds to such a case where the foundation composition of JP '323 is substituted for the first layer foundation composition of JP '122. Combinations 8, 9 and 11 correspond to the kit of the present invention.

From comparison between combination 6 and combinations 8, 9 and 11, it is clear that the kit of the present invention provides a very natural appearance as well as effectively concealing skin irregularities. Combination 6 is different from combinations 8, 9 and 11 in the amount of the reflection powder in the finishing composition. The finishing composition of combination 6 contains more than 10.0 wt.% of the reflection powder.

Moreover, the test results shown in Table 5 demonstrate that when only the first layer foundation composition of the present invention is used, concealment of irregularities in the skin is only improved slightly, and when the comparative first layer foundation composition is used, the effect of concealment of the irregularities in the skin is very poor. Furthermore, when the first layer foundation composition of the present invention and the second layer finishing composition of the comparative examples are used in combination (combinations 6 and 7), concealment of the irregularities in the skin was obtained, but a powdery, unnatural appearance was imparted to the skin.

It was unexpectedly discovered that when the first layer foundation composition of the present

invention, in combination with the second layer finishing composition of the present invention was used simultaneously (combinations 8, 9 and 11), BOTH excellent concealment of the irregularities in the skin was achieved, AND a very natural skin appearance imparted to the user, *i.e., a synergistic effect was obtained by use of the claimed combination of elements herein.*

It is believed that, in view of the legal authorities cited above, the test results herein clearly demonstrate patentability of the presently claimed invention based on unexpected and synergistic results. Therefore, it is believed that the Examiner would now be justified in no longer maintaining the rejection. Withdrawal of the rejection is accordingly respectfully requested.

In view of the foregoing, it is respectfully submitted that the application is now in condition for allowance, and early action and allowance thereof is accordingly respectfully requested. In the event there is any reason why the application cannot be allowed at the present time, it is respectfully requested that the Examiner contact the undersigned at the number listed below to resolve any problems.

Respectfully submitted,

TOWNSEND & BANTA

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DOCKET NO. SHI-015-USA-PCT

A handwritten signature in black ink, appearing to read 'Donald E. Townsend', with a stylized, sweeping flourish at the end.

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